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PATENT
P56975

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JUNG-KEUN AHN *et al.*

Serial No.:	10/698,433	Examiner:	LONEY, DONALD J.
Filed:	3 November 2003	Art Unit:	1772
For:	PLASMA DISPLAY PANEL		

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petitions from the Examiner's requirement set forth in the Office action mailed on 18 October 2005 (Paper No. 10142005), as reasons therefor state that:

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that, on 3 November 2005, this correspondence is being facsimile transmitted to the U.S. Patent & Trademark Office **(Facsimile No. 571-273-8300)**

Total 10 sheets

For Robert E. Bushnell
Reg. No. 27,774

Folio: P56975
Date: 11/3/05
I.D.: REB/kf

STATEMENT OF FACTS

1. On 18 October 2005, the Examiner mailed a first Office action (Paper No. 10142005). Paper No. 10142005 mentioned that the Examiner required labeling Figures 1 and 2 "Prior Art".

2. Three copies of Decisions on Petition for the following references previously issued by Group Directors to reverse similar requirements by other Examiners to label drawings "Prior Art", are enclosed:

   - Paper No. 21 issued on 25 February 1998 for U.S. Application Serial No. 08/447,279 filed on 22 May 1995;
   - Paper No. 15 issued on 2 October 1996 for U.S. Application Serial No. 08/343,939 filed on 17 November 1994; and
   - Paper No. (unknown) issued on 15 December 1999 for U.S. Application Serial No. 08/985,544 filed on 5 December 1997.

ARGUMENTS AND/OR REMARKS

In Paper No. 10142005, the Examiner erroneously maintained the objection on Figures1 and 2 to be labeled as "Prior Art". The Examiner states:

> "Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated."

Manual of Patent Examining Procedure (MPEP) §608.02(g) states:

> "Figures showing the prior art are usually unnecessary and should be cancelled, *Ex parte Elliott*, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."
>
> If the prior art figure is not labeled, form paragraph 6.36.01 may be used.
>
> Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. (See MPEP §608.02(g)."

Applicants have explained that Figures 1 and 2 are not "Prior Art".

First, in Paper No. 20050406, the Office action dated 14 April 2005, the Examiner asserted that "Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated" and cited §608.02(g) of the *Manual Patent Examining Procedure* (MPEP). The term "Prior Art" is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term "Prior Art" by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102, however, states that subject matter "which

is *old*" constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 20050406. In short, the age of the subject matter does not convert that subject matter into prior art, as the term "prior art" is defined by the law of the United States. Consequently, the Examiner's sole rational for imposing the requirement that Figures 1 and 2 be labeled as "Prior Art" is contrary to statute and improper. The requirement must be therefore be withdrawn.

Second, Figures 1 and 2 are not themselves believed to constitute "Prior Art" as that term is defined by either 35 U.S.C. §102 or 35 U.S.C. §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicants' belief or establish that Figures 1 and 2 constituted *prior art*, as that term is defined by statute. As evidenced from the Declaration/Oath, the Applicants are citizens of Republic of Korea, and, as such, devised Figures 1 and 2 in Korea in order to illustrate Applicants' discovery of problems plagued in the art. Therefore, since there is no showing that Figures 1 and 2 were known to anyone other than the Applicants ***in this country*** nor is there a showing that Figures 1 and 2 were ***patented or published in this country or a foreign country***, then Figures 1 and 2 can not be deemed to be "Prior Art" absent evidence to the contrary.

Third, Figures 1 and 2 are simply abstract representations of the art prepared by the Applicants in an effort to illustrate Applicants' discovery of problems plagued in the art in accordance with 37 C.F.R. §1.83(b); this discovery is itself, together with Applicants' abstraction of the art represented by Figures 1 and 2, part of the Applicants' invention. By

identifying deficiencies in the prior art and then addressing those deficiencies, Applicants complete the inventive process. As such, Applicants' effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g).

Fourth, there is no evidence that Figures 1 and 2 exist in any printed form other than in the present application and it's priority document. There is evidence to indicate that Applicants devised the subject matter in Figures 1 and 2 however, and that evidence lies in the fact that the only existence of Figures 1 and 2 are in the present application and it's priority document.

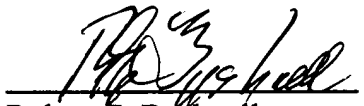
REMEDY REQUESTED

In view of the above, the Commissioner is respectfully requested to:

A. Withdraw the requirement to label Figures 1 and 2"Prior Art";

B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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Washington, D.C. 20231

Paper No. 21

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In re Application of)
Gwon-Il Kim)
Application Serial No.)
08/447,279) DECISION ON RENEWED
Filed: May 22, 1995) PETITION UNDER
For: SERVO CONTROLLER) 37 C.F.R. § 1.181
APPARATUS AND METHOD)
OF DISK RECORDING)
SYSTEM)

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya , 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

There is no requirement that a particular figure or figures be labeled as "prior art" The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

Gerald Goldberg, Director
Technology Center 2700-
Communications and Information Processing

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

#15

In re Application of :
MYUNG-CHAN JEONG :
Serial No: 08/343,939 :
Filed on : November 17,1994 :
For : DIGITAL SERVO CONTROL :
APPARATUS AND METHOD :
OF DATA STORAGE SYSTEM :
USING DISK RECORDING :
MEDIA :

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996 requesting the withdrawal of the requirement to label Fig. 3 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally filed and discussed was referred to as "CONVENTIONAL". Hence, in keeping with the disclosure and petitioner's arguments, the examiners' requirement to label this figure as "Prior Art" is incorrect and withdrawn.

Summary: The petition is Granted.

Jin F. Ng, Deputy Director
Examining Group 2500
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and Devices

JFN/AMP

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Group 3600

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In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT
DISPLAY DEVICE

P54947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is GRANTED.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues. 1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

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